

REMARKS

Claims 1-35 are currently pending in the application. Claims 1, 11, 23, and 35 are amended in this paper. No claims have been added or canceled. Claims 2, 22, and 34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Claims 1-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,014,644 to Erickson ("Erickson"). Applicant respectfully traverses these rejections for at least the reasons set forth below.

Claims 2, 22, and 34 Are Not Indefinite

Claims 2, 22, and 34 stand rejected under 35 U.S.C. § 112, second paragraph, because, the Office alleges, "one would not know the limitations of what a 'standard' document would be."¹ Applicant respectfully traverses this rejection, because Applicant's Specification provides the following definition:

Standard documents are documents that are in the standardized form recognized by GCD server 40 or documents that do not vary greatly between different buyers 20 and sellers 30 and would be easy to standardize over a given time period. The standardized form for each standard document varies depending on the document type. For instance the standardized form for a RFQ standard document is different from the standardized form for a purchase order standard document. Unique documents are documents that are not in the standardized form but generally in a format determined by buyer 20 or seller 30 and are generally more difficult to reduce to a standard form. Unique documents often contain terms and provisions specific to a particular buyer 20 or seller 30 which may not apply to all buyers 20 and sellers 30. Unique documents may vary greatly from each other.²

Applicant respectfully asserts that a person having ordinary skill in the art would appreciate the meaning of the term "standard document." Accordingly, it is

¹ Detailed Action, p. 2, II. 10-11.

² Specification, p. 17, II. 7-17.

respectfully requested that the rejection of claims 2, 22, and 34 be reconsidered and withdrawn.

Erickson Fails to Anticipate Amended Claims 1-35

As indicated above, claims 1-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Erickson. Applicant respectfully asserts that Erickson fails to disclose every limitation of each of the rejected claims in the same relationship to one another as set forth in each of the rejected claims. Moreover, Applicant respectfully submits that the Office has failed to establish a *prima facie* case of anticipation, because the Office has failed to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.

Independent claim 1, as amended herein, recites “one or more document repositories operable to store a plurality of transactional user documents used in a transactional phase of electronic commerce.” Independent claim 11, as amended herein, recites “storing a plurality of transactional user documents, used in a transactional phase of electronic commerce, in one or more document repositories.” Independent claim 23, as amended herein, recites “store a plurality of transactional user documents, used in a transactional phase of electronic commerce, in one or more document repositories.” Independent claim 35, as amended herein, recites “means for storing a plurality of transactional user documents used in a transactional phase of electronic commerce.” The remaining, rejected claims depend from one of these independent claims. Accordingly, the discussion *infra* concerning the independent claims applies equally to each of the claims dependent thereto.

Applicant’s Specification describes electronic commerce, or “e-commerce,” as involving a “matching” phase and a “transactional” phase. Referring to Figure 1, during the matching phase, a buyer 20 may search for a suitable product offered by one or more sellers 30, identify the most suitable seller 30, and contact that seller 30 to enter the transactional phase. During the transactional phase, the buyer 20

and seller 30 may negotiate a contract for the sale of the product and generate a legal document embodying the terms of the negotiated contract.³ The transactional phase involves the creation and use of one or more documents between buyer 20 and seller 30.⁴ Applicant's global content directory (GCD) 42 provides a way for transactional documents to become accessible to buyers 20 and sellers 30, so that negotiation and document creation costs are reduced. For example, without the use of GCD 42 in the transactional phase, buyer 20 may have to create new documents each time buyer enters into a new transaction with a seller 30 and then negotiate the legal and business points with seller 30, even though buyer 20 and seller 30 have had previous interaction, because there is no stored record of previous transactions.⁵

Erickson, however, cannot anticipate the rejected claims, because Erickson does not address any transactional aspect of electronic commerce. Erickson is solely concerned with a bidding process. Erickson's method stops prior to any transactional phase, as evidenced by the Table in column 16, which describes Erickson's process:

ACTION	PERFORMED BY
Submit Company Classification, and Product Information	Buyer and/or Suppliers
Maintain Global Database/Update Local Database	Service Provider/Buyer and/or Supplier
Browse Supplier Database and Assemble Supplier List	Buyer
Create Data cast	Buyer
Object Using Supplier List and Other Information	
Send Data cast Message to Suppliers	Buyer or Service Provider
Send Reminders to Suppliers	Buyer or Service Provider
Respond to Data cast Message	
Collect Supplier Responses	Suppliers
Analyze Supplier Responses	Buyer or Service Provider Buyer

Note that Erickson's process ends at the step "Analyze Supplier Responses," which is prior to any transactional phase, as defined by Applicant's Specification.

³ Specification, p. 6, l. 28, through p. 7, l. 6.

⁴ Specification, p. 8, ll. 3-4.

⁵ Specification, p. 8, ll. 4-25.

Moreover, Erickson fails to disclose or suggest any system, method, or software related to or concerning any aspect of a transactional phase of electronic commerce, as required by the rejected claims. Furthermore, Erickson is silent with regard to any transactional document. An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.⁶ For at least these reasons, Erickson fails to anticipate rejected claims 1-35.

Regarding the Office's response to Applicant's arguments concerning the meaning of the terms "decrypt" and "document," Applicant refers again to the Federal Circuit's decision in *Phillips v. AWH Corp.*,⁷ wherein the Court specifically instructs that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention."⁸ "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation."⁹ The Court references another of its decisions, in that "[w]e cannot look at the ordinary meaning of the term...in a vacuum. Rather we must look at the ordinary meaning in the context of the written description and the prosecution history."¹⁰ Moreover, the "intrinsic record 'usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim term to one or ordinary skill in the art at the time of the invention.'"¹¹ "[C]laims must be read in view of the specification, of which they are a part."¹²

⁶ *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

⁷ *Phillips v. AWH Corp.*, 03-1269, -1286 (Fed. Cir. July 12, 2005).

⁸ *Ibid*, slip op. at 9, citing *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) and *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003).

⁹ *Ibid*, slip op. at 9, citing *Innova*, 381 F.3d at 1116.

¹⁰ *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005).

¹¹ *Phillips*, slip op. at 10-11, citing *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1351 (Fed. Cir. 2004).

¹² *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), affd, 517 U.S. 370 (1996).

Mindful of the Federal Circuit's instructions discussed above, Applicant maintains that the Office has improperly construed the meaning of the terms "decrypt" and "document" in light of the present Specification, as it would be interpreted by one of ordinary skill in the art, for at least the reasons set forth in Applicant's Response to the Office Action of 29 July 2005.

Applicant further asserts that the Office has failed to establish a *prima facie* case of anticipation, because the Office has failed to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. The present Application includes 35 pending claims. Applicant respectfully assert that the Office has failed to indicate wherein the limitations of at least claims 9, 10, 14-17, 19, 20, 22, 27-29, 32, and 34. "[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."¹³ "It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office."¹⁴ Applicant respectfully asserts that Erickson is silent with regard to the limitations recited in claims 10, 14-17, 19, 20, 22, 27-29, 32, and 34. For at least these reasons, it is respectfully requested that the rejection of at least claims 10, 14-17, 19, 20, 22, 27-29, 32, and 34 be reconsidered and withdrawn.

The Legal Standard for Anticipation Rejections Under 35 U.S.C. § 102

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge:** The invention was publicly known in the United States before the patentee invented it.

¹³ *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

¹⁴ *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987).

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior

knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the

knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

CONCLUSION

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that the claimed invention would have been anticipated by Erickson. For the reasons set forth herein, the Applicant submits that claims 1-35 are in condition for allowance, and respectfully requests that claims 1-35 be allowed. The Examiner, however, is encouraged to call Applicant's representative, Daren Davis, at 817-578-8616, if he wishes to further explore the merits of the pending claims.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. 500777.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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